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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,289	03/25/2004	Akinori Iwase	016907-1600	5194
22428 7590 02/23/2007 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER HUNTSINGER, PETER K	
			ART UNIT	PAPER NUMBER
			2625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/808,289

Applicant(s)

IWASE ET AL.

Examiner

Peter K. Huntsinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/25/04</u> | 6) <input type="checkbox"/> Other: ____  |

### **DETAILED ACTION**

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 5/29/98. It is noted, however, that applicant has not filed a certified copy of the 10-150345 application as required by 35 U.S.C. 119(b).

### ***Information Disclosure Statement***

2. The information disclosure statement filed 3/25/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 19 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,724,492.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of U.S. Patent No. 6,724,492 recite an image forming apparatus for performing a trial preceding print, comprising: a receiver that receives a trial preceding print instruction to print a page of image data without an additional instruction (receiving means, lines 16-21); a printer configured to perform a trial preceding print by printing the page of image data received in response to receipt of the trial preceding print instruction, without the additional instruction (first printing means, lines 22-26); and a controller that sets a desired specification by operating a control panel after the printer performs the trial preceding print (setting means, lines 27-30), wherein the printer is further configured to print the page of image data according to the desired specification set by the controller (second printing means, lines 31-33).

It is noted that allowing this would result in an unjustified or improper timewise extension of the "right to exclude" granted by a patent.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 19-20, 22-28, 30-32, 34-40, and 42-47 are rejected under 35

U.S.C. 102(b) as being anticipated by Yoneda '157.

Referring to claim 19, Yoneda '157 discloses an image forming apparatus for performing a trial preceding print, comprising: a receiver that receives a trial preceding print instruction to print a page of image data without an additional instruction (partial print, see Fig. 12, col. 17-18, lines 64-68, 1-7); a printer configured to perform a trial preceding print by printing the page of image data received in response to receipt of the trial preceding print instruction, without the additional instruction (col. 17-18, lines 64-68, 1-7, without all output contents selected); and a controller that sets a desired specification by operating a control panel after the printer performs the trial preceding print (Fig. 11 shows printing options), wherein the printer is further configured to print the page of image data according to the desired specification set by the controller (the document can be printed and then printed again).

Referring to claim 20, Yoneda '157 discloses an image forming system comprising: a control panel (control display panel 117, col. 14, lines 63-66) including a first touch screen menu including a trial priming button configured to, when user selected, initiate a trial preceding print of a page of image data without an additional user selection (partial print, see Fig. 12, col. 17-18, lines 64-68, 1-7); and a printer that performs the trial preceding print by printing the page of image data in response to the selection of the trial printing button (col. 17-18, lines 64-68, 1-7, without all output contents selected); and a controller that sets a desired specification according to

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operation of the control panel after the printer performs the trial preceding print (Fig. 11 shows printing options), wherein the printer prints the page of image data according to the desired specification set by the controller (the document can be printed and then printed again).

Referring to claim 22, Yoneda '157 discloses a memory for storing the page of image data (page memory, see Fig. 6).

Referring to claim 23, Yoneda '157 discloses a scanner for scanning at least one original page to obtain a digital image thereof as the page of image data (scanner interface 40 of Fig. 3).

Referring to claim 24, Yoneda '157 discloses wherein the control panel further includes a second touch screen menu displayed after the printer performs the trial preceding print, the second touch screen menu including a print button configured to, when user selected, initiated printing the page of image data according to the desired specification set by the controller (see Fig. 11, the document can be printed and then printed again).

Referring to claim 25, see the rejection regarding claim 20 above.

Referring to claim 26, Yoneda '157 discloses a receiver that receives the image data using a communication line (col. 11, lines 4-15).

Referring to claim 27, Yoneda '157 discloses a scanner for scanning at least one original page to obtain a digital image thereof as the page of image data (scanner interface 40 of Fig. 3), and a memory for storing image data (page memory, see Fig. 6).

Referring to claim 28, see the rejection regarding claim 24 above.

Referring to claim 30, Yoneda '157 discloses an image forming apparatus comprising: a control panel (control display panel 117, col. 14, lines 63-66) including a touch screen trial printing button configured to, when user selected, initiate a trial preceding print of image data without an additional user selection (partial print, see Fig. 12, col. 17-18, lines 64-68, 1-7); and a printer that performs the trial preceding print by printing the image data in response to the selection of the trial printing button (col. 17-18, lines 64-68, 1-7, without all output contents selected); and a controller that controls printing of the image data by the printer, wherein the control panel further includes a plurality of print value buttons displayed after the printer performs the trial preceding print, the plurality of print value buttons configured to be user selectable to permit the user to change a specification for printing from a specification used for the trial preceding print (Fig. 11 shows printing options), and wherein the printer is further configured to, if the user changes the specification from the specification used for the trial preceding print, print the image data according to the changed specification controller (the document can be printed and then printed again).

Referring to claim 31, Yoneda '157 discloses wherein the control panel further includes a touch screen print button configured to, when user selected and if the user does not change the specification for printing, initiate printing of the image data according to the specification used for the trial preceding print (see Fig. 11, the document can be printed and then printed again).

Referring to claim 32, see the rejection regarding claim 20 above.

Referring to claim 34, see the rejection regarding claim 22 above.

Referring to claim 35, see the rejection regarding claim 23 above.

Referring to claim 36, see the rejection regarding claim 24 above.

Referring to claim 37, see the rejection regarding claim 20 above.

Referring to claim 38, see the rejection regarding claim 26 above.

Referring to claim 39, see the rejection regarding claim 27 above.

Referring to claim 40, see the rejection regarding claim 24 above.

Referring to claim 42, see the rejection regarding claim 30 above.

Referring to claim 43, see the rejection regarding claim 31 above.

Referring to claim 44, see the rejection regarding claim 20 above.

Referring to claim 45, see the rejection regarding claim 26 above.

Referring to claim 46, see the rejection regarding claim 27 above.

Referring to claim 47, see the rejection regarding claim 24 above.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 21, 29, 33, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneda '157 as applied to claims 20, 25, and 32 above, and further in view of well known prior art.



Referring to claim 21, Yoneda '157 discloses an image forming system comprising a printer, but does not disclose expressly a plurality of data processors that transfer images to the printer. Official Notice is taken that it is well known and obvious in the art to connect a plurality of computers to a printer (See MPEP 2144.03). The motivation for doing so would have been to allow printing from computers connected to the printer. Therefore, it would have been obvious to combine well known prior art with Yoneda '157 as in claim 21.

Referring to claim 29, see the rejection regarding claim 21 above.

Referring to claim 33, see the rejection regarding claim 21 above.

Referring to claim 41, Yoneda '157 discloses a process for performing a trial preceding print in an image forming apparatus, comprising: receiving an instruction in response to a selection of a trial preceding button in a first touch screen menu on a control panel (control display panel 117, col. 14, lines 63-66) of the image forming apparatus to initiate a trial preceding print of image data without an additional user selection (partial print, see Fig. 12, col. 17-18, lines 64-68, 1-7); performing the trial preceding print of the image data with a printer in response to the selection of the trial printing button (col. 17-18, lines 64-68, 1-7, without all output contents selected); setting a desired specification according to operation of the control panel after the printer performs the trial preceding print (Fig. 11 shows printing options); and printing the image data with the printer according to the desired specification set by the operation of the control panel (the document can be printed and then printed again). Yoneda '157 does not disclose expressly a plurality of data processors that transfer images to the

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printer. Official Notice is taken that it is well known and obvious in the art to receive image data at an image forming apparatus from at least one of a plurality of data processors (See MPEP 2144.03). The motivation for doing so would have been to allow printing from computers connected to the printer. Therefore, it would have been obvious to combine well known prior art with Yoneda '157 as in claim 21.

### ***Conclusion***

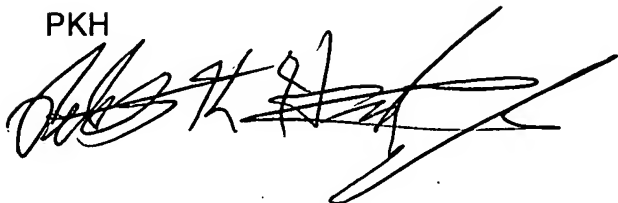

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moe Aung can be reached on (571)272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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PKH

A large, stylized handwritten signature in black ink, appearing to be the initials 'PKH' followed by a series of loops and flourishes.A handwritten signature in black ink, appearing to be 'AUNG S MOE' with a date '2/27/08' written to the right.

AUNG S MOE 2/27/08  
SUPERVISORY PATENT EXAMINER